Docket No.: 3350-42B
File No.: 1158.41327CC2
Client Ref.: MoneyWeb-B

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of :
GANESAN, et al : Group Art Unit: 1648
:
Serial No. 09/849,979 : Examiner: T. Brown
:
Filed: May 8, 2001 :
:
For: ELECTRONIC GREETING CARD WITH GIFT PAYMENT

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

February 15, 2005

Sir:

This Reply Brief is submitted in response to the Examiner's Answer dated December 16, 2004, to the Appeal Brief filed on September 20, 2004.

Objection to Section 8 of the Examiner's Answer Entitled "Grounds of Rejection"

The Examiner states that "the outstanding final grounds of rejection are presented as an Appendix to this Answer".

Sadly, what the Examiner contends to be "the outstanding final grounds of rejection" appears to be a modified version of the grounds for rejection presented in the final Official Action issued on April 19, 2004.

While the undersigned has not undertaken an exhaustive review of the differences between the grounds for final rejection set forth in the received final Official Action dated April 19, 2004 and grounds set forth in the Appendix which the Examiner asserts to be a presentation of "the outstanding final grounds of rejection", one noted inconsistency between the final Official Action and presented Appendix to the Examiner's Answer is the inconsistency in wording of the final paragraph on page 20 of

the Appendix and the first paragraph on page 21 (relating to claim 64) of the received final Official Action.

Accordingly, objection is made to the Appendix attached to the Examiner's Answer, and to the Examiner's statement, that the Appendix presents "the outstanding final grounds of rejection". It is respectfully submitted that the outstanding final grounds of rejection are as set forth in the final Official Action dated April 19, 2004 (a courtesy copy of which is attached hereto).

Objection is also made to any new arguments or grounds for rejection presented in the Appendix to the Examiner's Answer in view of the mandates of Rule 41.39, which require that any new grounds for rejection be designated as such and presented in the Examiner's Answer (not in an Appendix to the Examiner's Answer characterized as presenting nothing more than "the outstanding final grounds of rejection").

In view of the above, the undersigned strongly objects to the Appendix being considered as evidence in this case for any purpose relating to the prosecution of the subject application, and respectfully requests that the Appendix to the Examiner's Answer be stricken from the record.

No Prima Facie Basis Is Established For The Final Rejection

Rule 41.39 requires that the Examiner's Answer designate any "new grounds for rejection" as such. Since no such designation appears in the Examiner's Answer, it is understood that the Examiner maintains the rejections as set forth in the final Official Action dated April 19, 2004. Accordingly, this Reply Brief is directed to the Examiner's Response to Argument set forth on pages 3-12 of the Examiner's Answer in rebuttal of the arguments presented in the Appeal Brief.

1.) Claims 58, 63, 65-69 and 74-79 stand rejected under 35 USC §102(e) as anticipated by Van Dusen (U.S. Patent No. 6,175,823).

Independent Claims 58 and 69

As an initial matter, the Applicant's undersigned representative takes strong exception to Examiner's characterization of the Applicant's interpretation as a "contrived construction of electronic greeting card".

As detailed in the Appeal Brief and further herein, the Applicant's position regarding the meaning of "electronic greeting card" is supported not only by an identified dictionary definition, but also by the Examiner's own applied prior art. Indeed, the undisputed evidence presented in this case makes clear that "electronic greeting card" is a term of art, well understood to those in the applicable area of art to have the meaning that the Applicant attributes to it. The Examiner has not presented (or even identified) any evidence to rebut the evidence that has been presented by Applicant regarding the proper meaning of "electronic greeting card". Rather, the Examiner has chosen, throughout the examination of this application, to ignore the evidence presented as to the proper meaning "electronic greeting card" in the art.

For the Examiner to now characterize Applicant's position as a "contrived construction" is not only contrary to the record, but is quite frankly offensive.

In responding to arguments presented in the Appeal Brief that Van Dusen lacks any teaching relating to the generation of an "electronic greeting card" that includes a notification of the monetary gift, the Examiner points to the present application specification itself as teaching that the claimed generation of an electronic greeting card

reads on the generation of a conventional e-mail text message, as disclosed by Van Dusen (see Van Dusen's Figure 2 and disclosure of "e-mail-based gift certificate" in column 6, lines 8-9). That is, as understood the Examiner construes the recited generation of an "electronic greeting card" to be nothing more than the generation of a conventional e-mail text message (even though neither of claims 58 and 69 mentions an e-mail message or protocol).

As also understood, the Examiner reaches this conclusion based on the present applications disclosure that "the e-card site sends the e-card to the recipient via e-mail. As discussed above, the e-mail may be the entire e-card ..." (page 67, lines 13-15).

However, as discussed in detail in the Appeal Brief, the term "electronic greeting card", which are also commonly referred to as an "e-card" is a well recognized term of art, which is understood by those skilled in the art to have a very particular meaning. Indeed, not only dictionary definitions (see Appeal Brief) but the Examiner's own applied art (i.e., the Lenhart reference) recognize the terms "electronic greeting card" and "e-card" as terms of art which define a message having attributes different from those found in a text message (such as the conventional e-mail text message disclosed by Van Dusen in Fig. 2). In particular, as recognized by both the dictionary definition set forth in the Appeal Brief and the applied Lenhart publication, "electronic greeting cards" by definition include images, voices and/or music, in addition to the text greeting found in a conventional text message.

Thus, the Examiner relied upon disclosure in the present application (which states that "the e-card site sends the e-card to the recipient via e-mail. As discussed above, the e-mail may be the entire e-card ..." (page 67, lines 13-15)), would be understood by those skilled in the art, and hence should be construed, to require that,

in the latter case, the entire email may consist of the images, voices and/or music along with the text greeting forming the "electronic greeting card".

Therefore, it is respectfully submitted that each of independent claim 58 and independent claim 69 requires that a request for an electronic greeting card and the making of an associated monetary gift be processed to generate an electronic greeting card (e.g., a message having an image, music and/or voice, in addition to a text greeting) with a notification of the monetary gift. In this regard, it is perhaps worthwhile to highlight that the present application specification discloses that, preferably, the electronic greeting card (a.k.a. the e-card) could be presented via one of two protocols - either via an email protocol with the message being an attachment to an email or the email itself, or via an Internet protocol (e.g. html.) with the message being accessible from a Web server (e.g. via a hyperlink included in the email).

As perhaps best disclosed in Figures 1 and 2 of Van Dusen, what Van Dusen explicitly teaches is the receipt of a request to send an electronic greeting (not an electronic greeting card) and to make an associated monetary gift in a particular amount on behalf of a requesting donor to a designated recipient (as shown in Figure 1), and the processing of the received request to generate an electronic greeting (e.g., an email message having only a text greeting) with a notification of the monetary gift (as shown in Figure 2).

Hence, Van Dusen teaches only the generation of a text message having an electronic greeting (not an electronic greeting card), which includes a notification of a monetary gift. Thus, on its face, Van Dusen does not teach the generation of the electronic greeting card, as required by independent claims 58 and 69. Additionally, as will be detailed further below, the "monetary gift" Van Dusen teaches is indeed a gift

certificate, usable at only a sponsoring merchant(s) and not a deposit of funds into a deposit account at a financial institution.

Furthermore, the Examiner has neither asserted nor presented any rationale to support a conclusion that it is inherent in Van Dusen that the described e-mail message of Figure 2 is or could be an electronic greeting card (i.e. a message having image, music and/or voice, in addition to a text greeting).

Indeed, one can only speculate whether Van Dusen, which is concerned only with distributing and redeeming electronic gift certificates that by definition must be associated with a particular sponsoring merchant(s), such as Amazon.com (see the Albrecht reference) even recognized the benefit of marrying its described gift certificate for purchases at the sponsoring merchant (e.g. Amazon.com), with an electronic greeting card, let alone considered how this might possibly be accomplished.

It is respectfully submitted that in view of the explicit teachings of Van Dusen as well as that of the other prior art applied in support of other rejections (i.e. the Lenhart and Albrecht references), the Examiner could only have reached the conclusions asserted in the final Official Action and Examiner's Answer based on that which is disclosed in the present application specification, and by ignoring the explicit teachings of the Lenhart and Albrecht references as well as dictionary evidence as to the meaning of the term "electronic greeting card".

In summary, it is respectfully submitted that a prima facie basis for the rejection of claims 57 and 69 (and their dependencies) has not been established for the asserted rejection under 35 USC §102(e).

Accordingly, it is respectfully requested that the final rejection of these claims as anticipated by Van Dusen be reversed.

Claims 63 and 74

According to claims 63 and 74, the electronic greeting card, which includes the notification of the monetary gift, is transmitted to the recipient designated by the donor, and is then further transmitted via the network, to a non-designated recipient. A hyperlink in this further transmitted electronic greeting card is activated, and information identifying the non-designated recipient is received, via the activated hyperlink.

In the Appeal Brief grounds were presented as to why the basis for the Examiner's rejection of these claims could not be understood. More particularly, the inconsistency between what the Examiner contended to be taught in the section of Van Dusen referenced in support of the rejection and what was actually disclosed by Van Dusen in the referenced section, was highlighted. Also highlighted was a claimed limitation that had apparently been ignored.

In the Examiner's Answer, the Examiner asserts "the Examiner submits that this "designated recipient" is the same as Van Dusen's account identifier. This is because, like Applicant's "designated recipient", Van Dusen's account identifier is used to attribute a monetary gift to a specific designated recipient (column 4, lines 41-45). Furthermore, when Van Dusen's e-mail greeting card is sent to a single account, it is designated. That is, the account is identified such that e-mail greeting card is sent to a designated recipient. Van Dusen also provides that its e-mail greeting card may be sent to multiple, non-designated recipient accounts. When this is the case, the e-mail greeting card is sent with multiple hyperlinks. Each of these hyperlinks represents a separate account that has its own shipping address and credit card number (see column 4, lines 49-54). Thus, when the recipient of the e-mail greeting card selects one

of these hyperlinks, he is affectively transmitting the e-mail greeting card to a recipient, that was not initially designated. Accordingly, Van Dusen teaches the limitations of claims 63 and 74".

The Examiner's arguments are simply not understood.

The referenced text in column 4, relates to Figure 3, which depicts the web page displayed to the designated recipient after the designated recipient has received the e-mail greeting including the gift certificate (as shown in Van Dusen Figure 2). The Examiner contends (in rejecting other claims) that the e-mail greeting shown in Figure 2 corresponds to the required "electronic greeting card". However, in the rejection of claims 63 and 74, the Examiner contends that, rather than being the individual to whom the web page shown in Figure 2 is displayed, Van Dusen's designated recipient is an account identifier (although the Examiner never explains what the Examiner considers to be Van Dusen's "account identifier").

What is being described in the referenced text in column 4 relating to Figure 3, is what occurs after the designated recipient has already received the electronic greeting (not electronic greeting card) shown in Van Dusen's Figure 2. Therefore, according to Van Dusen's own disclosure, the "designated recipient" cannot be other than the individual to whom the web page shown in Figure 3 is displayed.

The Examiner asserts that "Furthermore, when Van Dusen's e-mail greeting is sent to a single account, it is designated. That is, the account is identified such that, e-mail greeting card is sent to a designated recipient".

However, the e-mail shown in Figure 2, which the Examiner contends (incorrectly) to correspond to the required electronic greeting card, in arguing the propriety of the rejection of other claims, has already been sent to the designated

recipient, prior to any selection by the designated recipient during the viewing of the Web page shown in Figure 3. That is, the Figure 3 Web page is only presented to the designated recipient after the designated recipient has activated the hyperlink in the transmitted e-mail greeting shown in Figure 2.

The Examiner goes on to baldly assert that "Van Dusen also provides that its e-mail greeting card may be sent to multiple, non-designated recipient accounts. When this is the case, the e-mail greeting card is sent with multiple hyperlinks. Each of these hyperlinks represents a separate account, that has its own shipping address and credit card number (see column 4, lines 49-54)".

However, contrary to the Examiner's assertions, the e-mail greeting shown in Figure 2, is not disclosed to be re-transmitted. Rather, what is discussed in the referenced text in column 4, is that instead of an e-mail greeting having a single hyperlink 30 as shown in Figure 2, the e-mail greeting could have multiple hyperlinks 30, each associated with a different one of the recipient's multiple accounts. In such a case, as can best be understood from Van Dusen's disclosure, by activating the hyperlink that is associate with the desired account, the recipient would be presented with the Web page shown in Figure 3, with the "your account" icon at the bottom of the Web page, shown in Figure 3, having a link which can be activated to the information for the desired account.

Thus, the relied upon disclosure in Van Dusen, lacks any teaching or suggestion of that which the Examiner contends to be disclosed. Furthermore, the Examiner has failed to identify any disclosure within Van Dusen (and it is respectfully submitted that there is no such disclosure) of a further transmission of the e-mail greeting shown in Figure 2 from the designated recipient to a non-designated recipient, as required in

claims 63 and 74.

Further still, the Examiner has failed to identify any disclosure within Van Dusen, which would reasonably support a conclusion that Van Dusen teaches or even suggests the activation of a hyperlink in a further transmitted e-mail greeting (let alone a further transmitted electronic greeting card), over which information identifying the non-designated recipient can be received for processing to determine if the identified non-designated recipient is a member of an enclosed community. Indeed, it appears that the Examiner has completely ignored these express claim limitations.

The Examiner also asserts that Van Dusen's disclosure in column 3, lines 55-60, of the debiting of the credit card account of the purchaser of the gift certificate (e.g., the donor) somehow teaches the crediting of a monetary gift to a deposit account associated with the non-designated recipient at a financial institute. It is respectfully submitted that the Examiner's position completely ignores express claim limitations, such as the requirement that the transaction be a crediting (not a debiting) transaction, and that the deposit account be associated with the non-designated recipient (not the donor). Indeed, Van Dusen fails to teach any crediting of any sort of retailer-independent deposit account.

Hence, not only is the Examiner's position in rejecting claims 63 and 74 inconsistent with positions taken by the Examiner in rejecting other claims, the position being taken by the Examiner regarding the teachings of Van Dusen to support the asserted rejection of claims 63 and 64 is inconsistent with the explicit teachings of Van Dusen itself.

Claim 75

While the Examiner recognizes that the issue is whether or not Van Dusen teaches that "the payment account of the donor is debited after the recipient of the greeting card activates the hyperlink" (emphasis added), the Examiner argues Van Dusen's disclosure that "when the recipient selects this hyperlink 30, the claim code is conveyed to the Web Site ... and is used by the site to automatically identify and credit the recipient's personal account" (emphasis added) anticipates the recited limitation.

However, the Examiner's position ignores the difference between debiting a donor's account and crediting a designated recipient's account. As disclosed in column 3, lines 55-63 of Van Dusen, the donor's credit card account is debited long before the electronic greeting with the hyperlink (as shown in Van Dusen's Figure 2) is even sent to the designated recipient. Indeed, Van Dusen is incapable of meeting the express limitations of claim 75.

Claims 66 and 77

As noted in the Examiner's Answer, claims 66 and 77, require that the request to send an electronic greeting card be received from an electronic greeting card service. Thus, according to these claims, it is the request received from the electronic greeting card service that is processed to generate the electronic greeting card, including the notification of the monetary gift, which is transmitted via the network to the designated recipient.

The Examiner asserts, without identifying any support for the assertion, that "this language reads on the simple command that is issued when Van Dusen transmits a purchased e-mail greeting card. This is because sending the e-mail greeting card to

the recipient, requires the greeting card service to submit a request to the recipient's internet service provider, such that the greeting card is delivered to the recipient. Thus, Van Dusen teaches having a greeting card service make the request to send the greeting send."

However, the Examiner's unsupported assertion ignores the claims' requirement that the request received from the electronic greeting service must be processed to generate an electronic greeting card having a notification of the monetary gift.

Thus, the position being taken by the Examiner regarding the teachings of Van Dusen to support the asserted rejection of claims 66 and 67 is inconsistent with the explicit teachings of Van Dusen itself. Furthermore even if Van Dusen were to teach what the Examiner contends that is teaches (which it is respectfully submitted is not the case), it would still fail to anticipate the invention of claims 66 and 77.

Claims 67 and 78

In the Examiner's Answer, the Examiner states that "applicant argues Van Dusen does not teach an electronic greeting card, or directing the crediting of funds to an account".

However, this statement is incorrect. What is being argued is that the Examiner has failed to establish any reasonable basis to conclude that Van Dusen teaches, or for that matter suggests, an electronic greeting card service [i.e. a particular type of first entity] (i) receiving a request to send an electronic greeting card and to make an associated monetary gift on behalf of a requesting donor to a designated recipient, (ii) generating an electronic greeting card which includes a notification of the monetary gift in response to the received request, and (iii) transmitting the generated electronic

greeting card to the designated recipient, but a payment service [i.e. a particular type of second entity and not the electronic greeting card service] directing the crediting the funds equal to the monetary gift amount to the deposit account.

The Examiner addressees Van Dusen's teachings generally relating to electronic greetings and the crediting of funds to an account, arguing that "Van Dusen teaches an electronic greeting card as noted under claims 58, 63, 65-69 and 74-79 above", and "directing a crediting of funds to an account", but fails to identify any particular disclosure within Van Dusen to support these assertions.

However, even if there is support for the Examiner's assertions, the Examiner continues to ignore the explicit limitations set forth in claims 67 and 78, which are entirely lacking in Van Dusen. In particular, the Examiner has failed to identify any teaching or suggestion within Van Dusen (and it is respectfully submitted that there is none) of an electronic greeting card service [i.e. a particular type of first entity] receiving the request, generating the electronic greeting including the notification of the monetary gift, and (iii) transmitting the generated electronic greeting to the designated recipient, and also of a payment service [i.e. a particular type of second entity and not the electronic greeting card service] directing the crediting the gift amount to the deposit account.

Claims 68 and 79

The Examiner correctly notes that the issue here is whether or not Van Dusen teaches transmitting a generated electronic greeting card to an electronic greeting card service.

The Examiner asserts that "Van Dusen teaches this feature through its process

for ordering an e-mail greeting card. This is because the user generates the e-mail greeting card by completing the form depicted in Figure 1. This form allows the user to identify, *inter alia*, the gift recipient and the gift amount. It is clear that this form automatically generates the e-mail greeting card, before transmitting it to the e-mail greeting card service, because completing and sending the form results in an irrevocable transmission of the completed e-mail greeting card; see "important" at the bottom of Figure 1".

Once again, no support is identified for the Examiner's asserted conclusions. Furthermore, the Examiner appears to now contend that the donor rather than the sponsoring merchant (e.g., Amazon.com) generates the e-mail greeting (shown in Figure 2) by completing the form, i.e., the gift certificate order form (shown in Figure 1). Indeed, the Examiner seems to contend that somehow the simple exercise of completing the Figure 1 form in and of itself generates the Figure 2 e-mail greeting, before the Figure 1 order form is ever transmitted to the merchant.

However, it is respectfully submitted that there is nothing in Van Dusen's disclosure to suggest that the e-mail greeting (as shown in Figure 2) is transmitted to the merchant along with the donor's order form (as shown in Figure 1).

If, on the other hand, the Examiner is arguing that the transmission of the gift certificate order form (as shown in Figure 1) is disclosed by Van Dusen to be the transmission of an e-mail greeting corresponding to the claimed electronic greeting card, this position would be inconsistent with the position taken by the Examiner in connection with the rejection of other claims. More particularly, the Examiner has argued in rejecting other claims, that the e-mail greeting shown in Figure 2 of Van Dusen (and not the gift certificate order form depicted in Figure 1 of Van Dusen), is

what corresponds to the claimed electronic greeting card.

Thus, the Examiner's position in rejecting claims 68 and 79 would appear to be inconsistent with positions taken by the Examiner in rejecting other claims, and/or the explicit teachings of Van Dusen itself.

2.) Claims 58, 65, 67-69, 75-76 and 79-80 stand rejected under 35 USC §103(a) as obvious over Van Dusen (U.S. Patent No. 6,175,823) in view of the Lenhart Publication.

Independent Claim 80

In the case of claim 80, the Examiner appears to recognize the weakness in the assertion that Van Dusen teaches the claimed request for, and generation and transmission of, an electronic greeting card (made in connection with other of the claims), and now proposes to substitute an electronic greeting card for Van Dusen's e-mail greeting, based on the teachings of Lenhart.

The Examiner states that "applicant argues the combination of Van Dusen, and Lenhart fails to teach various limitations recited in claim 80".

However, what is actually argued is that the combination of references fails to teach the claimed combination of limitations. Thus, while the Examiner identifies support within the individual references for individual limitations recited in claim 80, what the Examiner fails to identify is any suggestion within Van Dusen or Lenhart, for the modification which the Examiner proposes to make to meet the claimed combination of claim 80.

The Examiner asserts that the substitution of Lenhart's electronic greeting card

for Van Dusen's e-mail greeting, is motivated "because Lenhart's greeting would provide enhanced visual affects such as "moving images, voices and music" (Lenhart, p. 1, second paragraph). Thus, the combination of Van Dusen and Lenhart would have been obvious for at least this reason".

However, the Examiner has failed to identify any disclosure within either of the references that would motivate the applied combination of art or suggest the proposed modification of Van Dusen, to one skilled in the art at the time of the present application.

Van Dusen is directed to providing a vehicle for a sponsoring merchant(s), such as Amazon.com, to facilitate donors providing gift certificates to designated recipients for purchases at the sponsoring merchant. While Van Dusen provides for a simple electronic text greeting to be included with the e-mail notification of the gift certificate that the merchant generates and sends to the recipient, it is respectfully submitted that Van Dusen lacks any suggestion that the described e-mail text greeting shown in Figure 2 should or could advantageously be modified to include images, voices and/or music, so as to be in the form of an electronic greeting card. Indeed, according to Van Dusen, the simple e-mail text greeting and notification depicted in Figure 2 of Van Dusen, will solve all of the problems identified by Van Dusen in column 1, lines 34-51, in an "efficient and reliable" manner (see Van Dusen column 1, lines 49-51).

Thus, one can only ask why one skilled in the art would be motivated to increase complexity and potentially decrease efficiency and reliability by substituting an electronic greeting card with images, etc., for the simple e-mail text greeting shown in Figure 2 of Van Dusen?

Lenhart on the other hand, is interested only in the increased popularity and sale

of electronic greeting cards. Here again, Lenhart points out that electronic greeting cards have images, voices and/or music, and are growing in popularity and have numerous advantages over paper gift cards. However, Lenhart makes no suggestion that electronic greeting cards could or should advantageously be made to include a notification of a monetary gift.

It is respectfully submitted the what the applied art itself suggests is that neither Van Dusen, with its interest in merchant sponsored gift certificates for purchases to be made from the merchant, nor Lenhart, with its interest in selling electronic greeting cards, had the inspiration that it would be beneficial to combine an electronic greeting card with a monetary gift, or expended the perspiration to develop a enabling technique for doing so. Indeed, neither Van Dusen nor Lenhart provide any guidance as to how one might go about combining an electronic greeting card with a monetary gift.

Accordingly, it is respectfully submitted that the only motivation to modify Van Dusen to substitute the electronic greeting card disclosed by Lenhart in Van Dusen's e-mail text greeting and gift notification message is the present application disclosure itself, and the Examiner has failed to provide any reasonable basis for concluding otherwise.

Claims 58, 65, 67-69, 75-76 and 79

The issue of whether or not a prima facie basis for the obviousness rejection of claims 58, 65, 67-69, 75-76 and 79 has been established is not further addressed in the Examiner's Answer.

It is respectfully submitted that based on the arguments and evidence presented above with respect to the anticipation rejection of the claims 58, 65, 67-69, 75 and 79,

and the impropriety of the applied art combination and proposed modification of Van Dusen, the Examiner has also failed to establish a prima facie basis for the obviousness rejection of claims 58, 65, 67-69, 75-76 and 79.

3.) Claims 59-62, 64 and 70-73 stand rejected under 35 USC §103(a) as obvious over Van Dusen (U.S. Patent No. 6,175,823) in view of Albrecht (U.S. Patent No. 5,984,180) or alternatively in view of the Lenhart Publication and Albrecht.

Claims 59 and 70

The Examiner acknowledges that neither Van Dusen alone or in combination with Lenhart suggests the recited relation between the transmission of the generated electronic greeting card and the directing of crediting of funds to the deposit account, as required by claims 59 and 70.

As can be best understood, the Examiner first contends that these limitations are nothing more than an obvious change in the sequence of method steps.

However, claim 70 is directed to an apparatus, not a method, and thus for this reason alone the Examiner fails to establish a prima facie basis for the rejection of claim 70.

Additionally, it appears that the Examiner has not even considered, or has at least effectively ignored, the structural limitations of the apparatus of claim 70.

Furthermore, in support of the rejection the Examiner cites In re Lindberg, 194 F.2d 732, 93 USPQ 23 (CCPA, February, 1952) as standing for the proposition that a change in the sequence of method steps is unpatentable without a showing of "unexpected results".

However, it is respectfully submitted that the Lindberg decision issued prior to the adoption of the current Patent Statute in July 1952, and the Examiner has failed to present any evidence to establish that Lindberg remains valid law under the current Patent Statute.

Additionally even if "the changing of a sequence of steps in a method is obvious absent some unexpected result" under the current law (which is not admitted), claim 70 is directed to an apparatus and accordingly this principle, even if valid, would be inapplicable to claim 70.

Still further, it is respectfully submitted that what is being recited in claim 59 is not the mere sequencing of steps, but a specific relational limitation on the timing of the performance of particular steps to obtain an advantageous objective neither recognized nor met by the applied prior art.

More particularly, what claim 59 (as well as claim 70) recite a very particular timing relationship which requires that the transmission of the electronic greeting card having the notification of the monetary gift be delayed until the crediting of the funds in the amount of the monetary gift to the deposit account is directed. As for example described on page 68, line 31, through page 69, line 17, of the present application specification, by implementing the recited relationship between the timing of the directing of the credit and the transmission of the electronic greeting card, as required by claims 59 and 70, a hyperlink, such as that required by Van Dusen (see Figure 2 of Van Dusen), can be completely eliminated.

This is because in accordance with claims 59 and 70, the notification of the monetary gift is effectively a notification that the gift has been, or will shortly be, credited to the deposit account. This in turn results in the recipient obtaining the benefit of the

gift without further action being required by the recipient. In comparison, a notification of a gift, such as that in Van Dusen, necessarily requires further action on the part of the designated recipient in order to have the gift deposited in the deposit account so that the recipient can obtain the benefit of the gift. Thus, in accordance with the limitations of claims 59 and 70, the designated recipient has no need to contact a merchant (e.g. Amazon.com) or even a payment service provider (i.e. an entity capable of crediting the funds in the amount of the gift to the recipient) to obtain the benefit of the monetary gift.

Since the Examiner has failed to argue or identify any suggestion by Van Dusen that Van Dusen's described hyperlink 30 (see Figure 2) could be eliminated, let alone eliminated by modifying the relationship between features described by Van Dusen, the record evidences that the results of the recited timing relationship of claims 59 and 70 was unexpected at the time of the present invention.

The Examiner also asserts "In the present case, Applicant has simply modified Van Dusen to credit a recipient's account before transmitting the greeting card, rather than after transmitting the greeting card. This does not produce any unexpected result since the method still directs funds to a deposit account in connection with an electronic gift card. Therefore, modifying Van Dusen with the teachings of Albrecht is prima facie obvious."

The Examiner's position is not understood.

Even if the Examiner's assertion that "Applicant has simply modified Van Dusen to credit a recipient's account before transmitting the greeting card, rather than after transmitting the greeting card. This does not produce any unexpected result since the method still directs funds to a deposit account in connection with an electronic gift card"

were true (which it is respectfully submitted is not the case), how would this make modifying Van Dusen with the teachings of Albrecht is prima facie obvious"?

Although it is entirely unclear from the Examiner's Answer, to the extent the Examiner is proposing to modify Van Dusen or the combination of Van Dusen and Lenhart, based on the teachings of Albrecht, to cure the above noted Examiner acknowledged deficiency in Van Dusen and Lenhart, it is respectfully submitted that the Examiner still fails to establish a prima facie case for the rejection.

It is first noted that although Albrecht is cited in both the final Official Action and the Examiner's Answer in support of the rejection of claims 59 and 70, the Examiner has not identified any specific teaching within Albrecht, which discloses what the Examiner contends to be disclosed.

Furthermore, even if Albrecht discloses the crediting of a deposit account prior to the mailing of Albrecht's plastic gift credit card to the authorized user (i.e. the designated recipient), it is respectfully submitted that there is nothing within Albrecht, Van Dusen or Lenhart, to suggest that Van Dusen should or beneficially could be modified to transmit the electronic greeting shown in Figure 2, either subsequent to or concurrent with, the directing of the credit to the deposit account, as required by claims 59 and 70. In this regard, the Examiner has failed to identify any motivation for the applied combination or for the proposed modification of Van Dusen (or its combination with Lenhart) based on Albrecht, to meet the limitations of claims 59 and 70.

As will be detailed further below, it is also respectfully submitted that the proposed modification of Van Dusen (or its combination with Lenhart) based on Albrecht, to meet the limitations of claims 59 and 70, would be inconsistent with Van Dusen's own teachings and violate a principle of operation of Van Dusen. Since Van

Dusen is directed to gift certificates issued by and associated with a particular sponsoring merchant(s) (see Albrecht's description of gift certificates), it is also respectfully submitted that it is pure speculation to suggest that the proposed modification would be advantageous.

As described by Van Dusen in column 4, lines 24-66, a principle of Van Dusen's operation requires that the designated recipient activate the hyperlink 30 displayed to the designated recipient in the transmitted email text greeting and gift notification, to access the sponsoring merchant (Amazon.com) Website before the gift is directed to be deposited in the deposit account. This ensures that the merchant has the opportunity to promote its product offerings to the designated recipient for purchase with the credited account fund.

Thus, one can only ask what would motivate one skilled in the art to modify the disclosed Van Dusen operations, which beneficially (from the merchant sponsor's point of view) force a designated recipient to go to the sponsoring merchant Website in order to have a gift deposited and thereby provides the merchant with the opportunity to market its products to the designated recipient, to modify these described operations in a manner which would eliminate such a benefit.

While the Examiner in the final Official Action asserts that the modification is motivated because "it would ensure that the funds for the associated monetary gift are available prior to delivery of an indication of the monetary gift to the recipient", it is respectfully submitted that the only disclosure which suggest such a benefit is the present application disclosure, and that such a modification to Van Dusen would indeed be contrary to Van Dusen's own teachings and interests and would violate a principle of Van Dusen's operation.

Thus, while Van Dusen requires that the designated recipient of the gift certificate be subjected to the inconvenience of contacting a vendor (e.g., Amazon.com) to obtain the benefit of the gift, claims 59 and 70 completely eliminate the need for the recipient to be subjected to this inconvenience.

It is respectfully submitted that Applicant has not "simply modified Van Dusen to credit a recipient's account before transmitting the greeting card, rather than after transmitting the greeting card", as the Examiner contends. There are indeed unexpected results as perhaps best evidenced by the Examiner's own failure to recognize the beneficial result (from the gift recipient's point of view) obtained by modifying the timing of the crediting of the deposit account in relation to the time of transmission of the electronic greeting card with the notification of the monetary gift.

Claims 60 and 71

In the Appeal Brief reasons were presented as to why the Examiner's position in rejecting claims 60 and 71 could not be understood.

In the Examiner's Answer, the Examiner states "Applicant further notes that the Examiner's position is unclear because Van Dusen was previously stated as teaching a crediting of funds to a deposit account at a financial institution (e.g., claims 63 and 74). The rejection of claims 60 and 71 was offered in the alternative. That is, the rejection of claims 60 and 71 assumes, for the sake of argument, that Van Dusen lacks a deposit account financial institution. In any case, modifying Van Dusen to include crediting a deposit account at a financial institution would have been obvious in view of Albrecht".

These statements are also not understood. For example, one can only ask what the "rejection of claims 60 and 71 was offered in the alternative" to?

The Examiner goes on to assert that "Albrecht is disclosed as an improvement over ordinary monetary gift accounts. Albrecht uses a financial institution to provide a gift recipient with a deposit account that is accepted by any retailer (on-line or physical) that accepts ordinary credit cards (col. 3, lines 4-6). Based on this disclosure, one skilled in the art would have appreciated the value of giving a gift certificate that could be used to buy items at any retailer that accepts credit cards. Therefore, at the time of Applicant's invention, it would have been obvious to modify Van Dusen with the teachings of Albrecht".

As best understood, the Examiner acknowledges that Van Dusen alone, or in combination with Lenhart, lacks any teaching of directing the crediting of funds equal to the gift certificate amount to a deposit account at a financial institution. However, the Examiner contends Albrecht's disclosure that "the authorized user may use the gift credit card at any retail or other location which honors credit instruments issued by the sponsoring institution or a credit processing network to which the co-sponsoring institution belongs", suggests modification of Van Dusen to meet the limitations of claims 60 and 71.

However, Van Dusen is directed to the issuance of gift certificates which must be redeemed at a sponsoring merchant (Amazon.com), and to the funding a merchant (Amazon.com) account from which purchases of the sponsoring merchant's (Amazon.com's) products can be made (see column 1, line 59, through column 2, line 15).

Since Van Dusen is directed to gift certificates which are credited to a deposit account at the sponsoring merchant (e.g., Amazon.com) for use in purchasing products offered by the sponsoring merchant (Amazon.com), the question arises as to why one

would be motivated by Albrecht to modify Van Dusen so as to direct the crediting of the gift certificate amount to a deposit account at a financial institute (e.g., a Citizens Bank account) which would allow the deposited amount to be used in purchasing products offered by other than the sponsoring merchant?

It is respectfully submitted that, on its face, the Examiner's assertion that motivation exists would appear to be questionable. Furthermore, since the Examiner has provided no objective evidence or any reasonable rationale in support of the Examiner's contention, it can only be concluded that the Examiner's finding of motivation is based on pure speculation.

Additionally, in view of Van Dusen's objectives, it is respectfully submitted that the crediting of the amount of the gift certificate to a deposit account at the sponsoring merchant (e.g., Amazon.com) is a principle of operation of Van Dusen. This principle of operation ensures that the gift certificate amount must be spent only on purchases from the sponsoring merchant.

Since modifying Van Dusen as proposed by the Examiner to meet the limitations of claims 60 and 71, would require crediting of the gift certificate funds to an account maintained at a financial institution and thereby allow the funds to be spent on purchases from merchants other than the sponsoring merchant (or saved and not spent at all if so desired by the recipient), such a modification would necessarily violate a principle of operation of Van Dusen.

Claim 64

In the Appeal Brief, it was noted that the final rejection completely ignores the requirement that the payment account be at a financial institution associated with the

donor.

In response, the Examiner "directs the Board's attention to the rejection of claim 64 from the Exhibit. There the rationale for the combination of Van Dusen and Albrecht is stated. The Examiner also incorporates by reference the discussion of claims 60 and 71".

Since there is no "Exhibit" to the Examiner's Answer, as understood the Examiner intended to reference the Appendix to the Examiner's Answer, which according to the Examiner presents "the outstanding final grounds of rejection".

However, as discussed above, what the Examiner directs the Board's attention to (i.e. the Appendix) is not what it is purported to be. Although the Examiner asserts that the Appendix presents "the outstanding final grounds of rejection", the Appendix in fact presents a modified version of the final grounds of rejection presented in the Final Official Action issued by the USPTO on April 19, 2004. Furthermore, there is no indication in the Appendix that identifies what modifications have been made to the final grounds of rejection presented in the Final Official Action. The undersigned has found nothing in the Examiner's Answer to apprise Applicant or the Board of the changes to the final grounds of rejection (presented in the Official Action of April 19, 2004) reflected in the Appendix.

Accordingly, the undersigned strongly objects to the Appendix being considered evidence in this case, whether for purposes of establishing what the Examiner has or has not ignored, or for any other purpose relating to the prosecution of the subject application.

It is respectfully submitted that the Examiner's Answer does not cure the deficiency in the support for the previously asserted rejection of claim 64.

First it is noted that, in addition to directing the Board's attention to a modified version of the final grounds of rejection, the Examiner states that "The Examiner also incorporates by reference the discussion of claims 60 and 71.

It is respectfully submitted that the incorporation by reference of a discussion relating to other claims fails to provide Applicant with a sufficient basis to form a reasonable understanding of rationale for the rejection of claim 64.

Claim 64 requires the debiting of the donor's deposit account at a financial institution subsequent to the activation of a hyperlink included in the transmitted electronic greeting card.

Even if Albrecht were to disclose the debiting of a donor's deposit account at a financial institution (which is not admitted), at best Albrecht's debiting would be performed after the plastic gift card is mailed or otherwise given to the designated recipient and has nothing whatsoever to do with activation of a hyperlink included in the transmitted electronic greeting card.

Hence, it is entirely unclear how modifying Van Dusen in accordance with Albrecht (even if the combination were motivated, which it is respectfully submitted is not the case for reasons discussed above, and the proposed modification were proper, which it is also respectfully submitted is not the case for reasons discussed above) would result the debiting of the donor's deposit account at a financial institution subsequent to the activation of a hyperlink included in a transmitted electronic greeting card as required by claim 64.

Thus, it is respectfully submitted that the Examiner's Answer also fails to address the express limitations of the claims.

4.) Claim 81 stands rejected under 35 USC §103(a) as obvious over Van Dusen (U.S. Patent No. 6,175,823) in view of the Lenhart Publication and Official Notice.

Claim 81

As an initial matter, the Applicant's undersigned representative takes strong exception to Examiner's characterization of the Applicant's recitation that "the funds are directed to be credited to the deposit account from the deposit account associated with the service provider" as "convoluted language".

While there appears to be no reluctance in making such an assertion, the Examiner does not even show the courtesy of stating a basis for it.

The Examiner's disparagement of Applicant's claim language, it is respectfully submitted, is not only a mischaracterization of the claim 81 recital but is also entirely inappropriate (particularly in an Official USPTO document).

Accordingly, the undersigned respectfully requests that the Examiner assertion be stricken from the record of this case.

The Appeal Brief highlights that the portions of the publications, which the Examiner identified to support the Official Notice, lack any disclosure that can be read to reasonable support the Official Notice.

The Examiner states that "As understood by the Examiner, Appellant argues that the documents used to support the Examiner's assertion of Official Notice do not teach the claim limitations."

This statement is incorrect. In the Appeal Brief, it is argued that what the Examiner has offered in support for the Official Notice fails to provide the requisite support and therefore the Official Notice is improper and should be withdrawn.

In response, the Examiner now states "Official Notice was taken that the broad limitation, wherein the funds are directed to the credited to the deposit account from the deposit account associated with the service provider, was old and well known in the art ... this limitation reads on one bank customer, depositing funds in another bank customer's account, wherein the customer's belong to the same bank. As demonstrated by the references offered by the Examiner, this step is neither new or non-obvious, when viewed in the light of Van Dusen. This is because the combination of Van Dusen and the Examiner's Official Notice would make it possible for the gift owner and the gift recipient to have a common creditor, such as Visa. The combination of Van Dusen and the Examiner's Official Notice is therefore proper".

The Examiner's Answer is not understood.

Claim 81 requires that debiting of funds equal to the monetary gift amount be directed from a deposit account at a financial institution associated with the requesting donor to a deposit account at a financial institution associated with the service provider. The claim also requires that crediting of funds to the deposit account of the designated recipient be directed from the deposit account associated with the service provider.

The Examiner's Answer does not even consider the limitations relating to the debiting of the donor's deposit account, or the crediting of the debited funds to a service provider's deposit account at a financial institution.

Furthermore, neither of the references cited in support of the Official Notice, disclose such limitations. Indeed, the Bank Technology News publication has no need for the required debiting.

The Examiner's current reference to "one bank customer depositing funds into another bank customer's account, wherein the customer's belong to the same bank" is

quite simply not understood.

There is no requirement in claim 81 for such limitations. Indeed, claim 81 does not recite such direct movement of funds between the donor's and the recipient's respective deposit accounts. Rather, what claim 81 is directed to is a service provider debiting the donor's deposit account to transfer funds from the donor's deposit account to the service provider's deposit account, and the service provider then crediting funds from the service provider's deposit account to the recipient's deposit account. The deposit accounts of the donor and service provider may be at either the same financial institution or different financial institutions.

Features Recited In Each Of The Independent Claims and Numerous Dependent Claims Are Neither Taught Nor Suggested By The Applied Prior Art Whether Taken Individually Or In Any Combination

It is again respectfully submitted that the features and limitations identified on pages 21-29 of the Appeal Brief patentably distinguish the associated claims noted over the applied prior art

In conclusion, it is respectfully submitted that the Examiner (i) has failed to establish a prima facie case for the rejection, (ii) has proposed to modify the applied art in a manner which is unmotivated, (iii) has failed to apply art which teaches or suggests the claimed invention, and (iv) has, at best, attempted to improperly reconstruct the invention using the present applications own disclosure or relied on pure speculation in rejecting the claims.

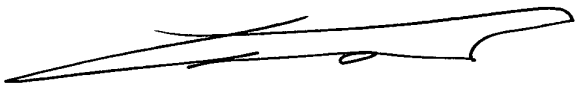
Thus, the rejection of the pending claims is in error, and reversal is clearly in order and is courteously solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 01-2135 and please credit any

excess fees to such deposit account.

Respectfully Submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP



Alfred A. Stadnicki

Registration No. 30,226

Suite 1800
1300 North Seventeenth Street
Arlington, VA 22209
Telephone: (703) 312-6600
Facsimile: (703) 312-6666

AAS/slk